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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/147,325	02/17/1999	MATS LEIJON	9847-0001-6X	1549

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EXAMINER

MULLINS, BURTON S

ART UNIT PAPER NUMBER

2834

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/147,325

**Applicant(s)**

LEIJON ET AL.

**Examiner**

Burton S. Mullins

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 77-158 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 77,78,117,119 and 153 is/are rejected.
- 7) ☒ Claim(s) 79-116,118,120-152 and 154-158 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. Claim 121 is objected to because of the following informalities: Claim 121 should depend from claim 120 rather than claim 44, which was canceled. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. Claim 153 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not describe a "means for separating said first equipotential surface from said second equipotential surface...said means for separating including an extruded material is configured to prevent said stator winding from being damaged when drawn through said first slot, said second slot, and said third slot." The only description of an extruded material in the specification is found on p.10, line 1, where applicant describes a cable embodiment in which corrugations are produced directly on the outer semiconducting layer of the cable by extruding the outer semiconducting layer 234a. This is generally shown in Fig.11, with the corrugations further discussed on p.17, lines 1-11. The extruded outer semiconductor layer described on p.10, line 1, contrasts with the "means for separating including an extruded material", which is not taught or described in the specification. The means for separating the first equipotential surface 32 from the second

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equipotential surface 34 appears to be an insulation layer 33 (Fig.2; p.13, lines 6-8) and is not the same element as the outer semiconducting layer described on p.10, line 1.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 77-78, 117 and 119 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1/13/14 of copending Application No. 08/952,993 in view of Wood (British Patent 1,135,242). The combined claims 1/13/14 of the '993 application teach an electromagnetic device (of which a stator with slots is a species) including the same cable structure with inner and outer

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equipotential semiconducting layers separated by a solid insulation wherein the outer layer may comprise an extruded layer simultaneously formed with the extruded layer of the solid insulation (claim 14 of the '993 application). The combined claims 1/13/14 of the '993 application differ in that they do not teach a support member positioned in contact with the cable.

Wood teaches a support for coils comprising a packing means for conductors in stator slots of a dynamo-electric machines. The packing means is suitable for high power generators and is inflated with a pressurized fluid medium. Furthermore, the packing means exert pressure resiliently against the conductors, both radially and tangentially, consisting of inflatable tubes extending axially along each slot or connected to a common manifold. The use of inflatable packing means facilitate insertion and make it possible to achieve compressive resilience to compensate for any shrinkage of conductor isolation. Wood further teaches that the packing means can be either connected to a supply of pressurized fluid medium by means of a common manifold or if the fluid medium is elastically compressible, each packing means may be sealed at both ends after inflation. The elastically compressible medium can be made of elastomeric material such as silicone rubber.

It would have been obvious to modify the structure disclosed by claims 1/13/14 of the '993 application and provide a support member per Wood since this would have made it possible to achieve compressive resilience to compensate for any shrinkage of cable conductor isolation.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Regarding claim 78, see claim 12 of the '993 application.

*Allowable Subject Matter*

5. A timely filed terminal disclaimer would overcome the above double patenting rejection of independent claims 77, 117 and 119. The following is a statement of reasons for the indication of allowable subject matter of those independent claims: The prior art of Shildneck, Elton and any one (or combination of) Wood, Mazzorana, Grant or Madsen, do not teach or suggest that the outer semiconducting layer is formed from an extruded material that is configured to protect said stator winding from being damaged when drawn through said first slot, said second slots and said third slot. Applicant's specification p.9, line 27-p.10, line 2 describes a cable embodiment in which corrugations are produced directly on the outer semiconducting layer of the cable by extruding the outer semiconducting layer 234a. See Fig.11 and specification p.17, lines 1-11. In Elton, the outer semiconducting layer 110 (Fig.7) comprises a semi-conducting pyrolyzed glass fiber layer which "can be chopped, mixed with resin and molded, or blown on any complex shaped substrate..." (c.8, lines 3-5). Elton does not teach or suggest extrusion of the outer semiconducting layer. Neither Shildneck, Wood, Mazzorana, Grant nor Madsen remedy the deficiencies of Elton.

*Conclusion*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Burton S. Mullins whose telephone number is 571-272-2029. The examiner can normally be reached on Monday-Friday, 9 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on 571-272-2034. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



BURTON S. MULLINS  
PRIMARY EXAMINER

7/13/04